

REMARKS:

Claims 1-31 are currently pending in the application.

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,957,199 B1 to Fisher ("*Fisher*") in view of U.S. Publication No. 2002/0178127 to Byde (*Byde*).

Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *Byde*, and in further view of U.S. Publication No. 2002/0040352 to McCormick ("*McCormick*").

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The Applicants respectfully disagree and respectfully traverse the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph.

In the Response to Arguments section of the Office Action dated 17 July 2007, and with regard to Claims 1-31, the Examiner asserts that:

- 1) "The phrase 'meta-model elements' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention;"
- 2) "The applicant appears to define a meta-model to be a trading partner agreement;"
- 3) "The repetitious use of the term meta-model to define different aspects of meta-models is vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be;"

- 4) “How do these element describe a portion of a potential standard for collaboration?;” and
- 5) “Thus a broad interpretation to the phrase meta-model is applied.”
(17 July 2007 Office Action, Page 2).

For at least the reasons set forth at length below, the Applicant respectfully disagrees and respectfully traverses the Examiner’s rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph.

The Applicants Claims are Definite

First, the Specification at least at Page 3, Lines 7-12 provides clear support for at least the Claim portion “meta model element”. Specifically:

Each meta-model element in the set is ***capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-model...***

In addition, independent Claim 1 claims at least:

A set of one or more meta-model elements each ***capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-model...***

While the Examiner has not set forth precisely which “limitations following the phrase” meta-model elements are unclear as “part of the claimed invention,” what *is* clear is that the further limitation “***capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-model***” has clear support in the specification, as shown above. Moreover, the presence in Applicants Claims of the further limitation “meta-model elements each capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-mode” clearly signifies that Applicants are Claiming at least a meta-model element containing at least the further limitation “each capable of being

negotiated by two or more enterprises and incorporated into a negotiated meta-mode” which, once again, has clear support in the Specification.

Applicants therefore respectfully submit that for at least the reasons that the further limitation “each capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-mode” clearly further limits the claim element “meta-model element”, and since the further limitation has clear support in the specification, the presence of this further limitation simply does not render the claim indefinite. For at least these reasons, Applicants’ claims are definite and therefore should be allowed.

The Term ‘Meta-Model’ is Clearly Defined in the Specification; The Examiner has Improperly Defined the term ‘Meta-Model’

In the Response to Arguments section, the Examiner inexplicably asserts that “the *applicant appears to define a meta-model to be a trading partner agreement*”. (17 July 2007 Office Action, Page 2). (Emphasis Added).

Notwithstanding the Examiner’s definition to the contrary, the *Applicants Specification clearly defines the term “meta-model” at least as describing “an agreement between the enterprises as to collaborations between the enterprises.”* (Specification at Page 3, Lines 17-18).

Therefore, the Applicants respectfully submit that the Examiner has improperly crafted a definition of the term “*meta-model*” despite there being clear support for the term in the Applicants specification. As shown by comparison above, the Applicants respectfully submit that the Examiner’s construction of the term “*meta-model*” fails to account for significant aspects of Applicants “*meta-model*” as set forth in the specification. Accordingly, the Applicants respectfully submit that the Examiner’s imputed definition of “*meta-model*” is improper in light of the clear definition provided for the term in Applicants specification.

The Applicants are Entitled to the Broadest Reasonable Interpretation of Their Claims Consistent with the Specification.

It is well-settled that claims must be given their “broadest reasonable interpretation” in light of the specification. (see MPEP §2111). Specifically, an examiner must interpret “verbiage of the proposed claims [in] the broadest reasonable meaning in their ordinary usage as they would be understood by one of ordinary skill in the art, ***taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.***” (MPEP 2111, citing *In re Morris*, 127 F. 3d. 1048, 1054-55, 44 USPQ2d 1023, 1027-27 (Fed. Cir. 1997)).

As noted above, at least the term “***meta-model***” is clearly defined at least in the Applicants specification. Therefore, the Applicants respectfully submit that the Examiner’s construction of the term “***meta-model***” in a manner inconsistent with the Applicants specification and is in plain error. In fact, as noted above, the Applicants specification clearly defines the term “***meta-model***” at least as describing “an agreement between the enterprises as to collaborations between the enterprises”. (Specification at Page 3, Lines 17-18.) Therefore, in light of the clear definition provided in the specification for the term “***meta-model***” the Applicants are unclear as to why the Examiner has inexplicably crafted a definition of the term “***meta-model***” that is inconsistent with the clear definition provided at least in Applicants’ specification.

The Applicants respectfully submit that the Applicants specification provides clear support for at least the term “***meta-model.***” Accordingly, the Applicants respectfully submit that the Examiner’s attempted construction of a definition of the term “***meta-model***”, in contravention of the specification, is not only not “reasonable” it is plainly improper. Thus, the Applicants respectfully submit that Examiner’s construction of a definition for the term “***meta-model***” is improper, particularly in light of the fact that the Applicants specification provides at least clear support for the term.

Each Instance of the Term “*Meta-Model*” in Applicants Claims is Clearly Defined

In the Response to Arguments section, the Examiner asserts that “the repetitious use of the term meta-model to define different aspects of meta-models is vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be”.

Notwithstanding the Examiner’s assertion, the Applicants respectfully submit that the relationship between each and every instance of the term “*meta-model*” in the Applicants claims are clearly defined at least in the specification, as well as being clear in the claims themselves. The Applicants respectfully submit that, beyond making a generalized conclusion, the ***Examiner does not set forth any reasoning*** to indicate why it is believed that the clearly defined use of the term meta-model point is considered “vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be”.

In any event, the term “*meta-model*” is used in the Applicants independent Claim 1 only in the following ways:

- A) “*meta-model elements*” (Claim 1, Line 3);
- B) “*negotiated meta-model*” (Claim 1, Line 5);
- C) “*meta-model negotiation service*” (Claim 1, Line 9).

The relationships between the different usages of the term “*meta-model*” are clearly set out at least in the Applicants specification, as well as in the Applicants claims.

The Meaning of the Term “*Meta-Model Elements*” is Clearly Defined

Specifically, as noted above, the term “*meta-model element*” is defined at least in Applicant’s specification at Page 3, Lines 7-13. Since, as noted above, the further limitation of “capable of being negotiated by two or more enterprises and incorporated into

a negotiated meta-model” is present at least in both the Applicants specification, as well as the Claims. Therefore, since the term “**meta-model element**” is clearly defined at least by the Applicants in the specification, and since the language of independent Claim 1 at least parallels the term “**Meta-model element**” as defined at least in Applicants’ specification, the Examiner’s lack of clarity with regard to the use of this term is inexplicable. Accordingly, Applicants respectfully submit that the meaning of the term “**meta-model element**” is clear in light of the Applicants specification and claims.

The Meaning of the Term “Negotiated Meta-Model” is Clearly Defined

In addition to the foregoing, the term “**negotiated meta-model**” is defined at least in the Applicants Specification at Page 3, Lines17-18. In particular, the term “**negotiated meta-model**” is defined in the Applicants specification at least as “a negotiated meta model that **describes an agreement between the enterprises as to collaborations between the enterprises**”. (Specification at Page 3, Lines17-18). Likewise, independent Claim 1 claims at least a “negotiated meta-model **describing an agreement between the enterprises as to collaboration between the enterprises.**”

Accordingly, since the term “**negotiated meta-model**” is clearly defined at least by the Applicants in the Specification, and since the language of independent Claim 1 uses the term “**negotiated meta-model**” as defined at least in the Applicants specification, the Applicants respectfully submit that the meaning of the term “**negotiated meta-model**” is clear in light of the Applicants specification and claims.

The Meaning of the Term “Meta-Model Negotiation Service” is Clearly Defined

In addition, the term “**meta-model negotiation service**” is defined at least in the Applicants Specification at Page 3, Lines12-18. In particular, the term “**meta-model negotiation service**” is defined in the Applicants specification at least as “operable to **receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the enterprises**”. Likewise, independent Claim 1 claims at least a “meta-model negotiation service operable to “**receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the**

enterprises". Accordingly, since the term "**meta-model negotiation service**" is clearly defined by the Applicants at least in the Specification, and since the language of independent Claim 1 uses at least the term "**meta-model negotiation service**" as defined at least in the Applicants specification, the Applicants respectfully submit that the meaning of the term "**meta-model negotiation service**" is clear in light of the Applicants specification and claims.

Moreover, further support is found for the term "**meta-model negotiation service**" in the Applicants Specification at lines 14-18. Specifically, "the meta-model negotiation service provides access to the set of meta-model elements and receives selections of one or more of the meta-model elements." (Specification Page 3, Lines 14-18).

Applicants are Entitled to the Broadest Reasonable Interpretation of Their Claims Consistent with the Specification

As noted above, Claims must be given their "broadest reasonable interpretation" in light of the specification. (see MPEP §2111). Specifically, once again, an examiner must interpret "verbiage of the proposed claims [in] the broadest reasonable meaning in their ordinary usage as they would be understood by one of ordinary skill in the art, **taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.**" (MPEP 2111, citing *In re Morris*, 127 F. 3d. 1048, 1054-55, 44 USPQ2d 1023, 1027-27 (Fed. Cir. 1997)).

In the Response to Arguments section, the Examiner indicates that "[t]hus a broad interpretation to the phrase meta-model is applied." (17 July 2007 Office Action, Page 2). Notwithstanding the Examiner's assertion that a *broad* interpretation of the term "**meta-model**" has been applied in the instant matter, as noted above, the Applicants respectfully submit that the Examiner has improperly asserted a narrow interpretation of the term "**meta-model**."

Specifically, as noted above, the Applicants Specification clearly defines the term "**meta-model**" at least as describing "an agreement between the enterprises as to

collaborations between the enterprises”. (Specification at Page 3, Lines 17-18.) Therefore, the Applicants respectfully submit that it is unclear why the Examiner has chosen to craft a definition of the term “**meta-model**” in light of the fact that the Applicants have previously clearly defined at least that term at least in their specification. In addition, the Applicants respectfully submit, that the Examiner’s characterization that “a broad interpretation to the phrase meta-model is applied.”

As is clear, the Applicants definition of the term “**meta-model**” is at least “an agreement between the enterprises as to collaborations between the enterprises”. (Specification at Page 3, Lines 17-18). Therefore, the Applicants respectfully submit not only that the Examiner has improperly crafted a definition when clear support was already provided at least in the Applicants specification, but also that the Examiner’s interpretation of the term “**meta-model**” is unduly narrow in light of the clear requirement that claims must be given their “broadest reasonable interpretation” in light of the specification. (see MPEP §2111).

Accordingly, the Applicants respectfully submit that the Examiner has improperly crafted an unduly narrow definition of the term “**meta-model**” especially in light of the Applicants Specification as well as the requirement that claims be given their broadest reasonable interpretation in light of the specification.

For at least the reasons set forth above, the Applicants respectfully submit that the rejection of Claims 1-31 under 35 U.S.C. §112, second paragraph, is improper and should be withdrawn.

REJECTION UNDER 35 U.S.C. § 103(a)

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 103(a) under *Fisher* in view of *Byde*. Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *Byde*, and in further view of *McCormick*.

In the Response to Arguments section of the Office Action dated 17 July 2007, and with regard to Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31, the Examiner asserts/acknowledges that:

- 1) "The term meta-model is viewed as a trade agreement"
- 2) "*Fisher* does not use the exact phrasing of negotiation in reference to trade agreements. However, *Byde* teaches negotiations"
- 3) "*Fisher* teaches negotiations [sic] trade agreements, and the rules within trading"
- 4) "*Byde* teaches on the specifics of negotiation"
- 5) "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Fisher* to include more details regarding negotiations"
- 6) "Though *Fisher* may not state negotiations around the term trade agreement it is viewed that trade agreements require by nature negotiations" and
- 7) "The term negotiation means to confer with another or others in order to come to terms or reach an agreement. Within the confines of the definition of the phrase trade agreement is the idea of a negotiation."

Each of the Examiner's assertions/acknowledgements will be discussed in turn. For at least the reasons set forth at length below, the Applicants respectfully disagree and respectfully traverse the Examiner's rejection of Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 under 35 U.S.C. § 103(a).

The Examiner has Improperly Defined the Term '*Meta-Model*'

In the Response to Arguments section, the Examiner asserts that "the applicant appears to define a meta-model to be a trading partner agreement." (17 July 2007 Office Action, Page 2). As discussed above, and notwithstanding the Examiner's definition to the contrary, the Applicants specification clearly defines the term "***meta-model***" at least as

describing “an agreement between the enterprises as to collaborations between the enterprises.” (Specification at Page 3, Lines 17-18.)

Therefore, the Applicants respectfully submit that the Examiner has crafted a definition of the term “**meta-model**” despite there being clear support for the term in the Applicants Specification. Accordingly, the Applicants respectfully submit that the Examiner’s definition of “**meta-model**” is improper in light of the clear definition provided for the term in the Applicants Specification.

Examiner Acknowledges that *Fisher* Does not Use the Exact Phrasing of Negotiation in Reference to Trade Agreements

The Applicants respectfully submit that *Fisher* does not teach, suggest, or even hint at a “**negotiated meta-model**”, as recited in independent Claim 1. The Applicants respectfully submit that ***the Examiner acknowledges that Fisher does not teach “negotiation in reference to trade agreements”***. (17 July 2007 Office Action, Page 4).

The Applicants respectfully submit that it is logically inconsistent, and therefore improper, for the Examiner to acknowledge that *Fisher* does not teach “negotiation in reference to trade agreements,” but otherwise assert that *Fisher* does somehow teach “communicating the **negotiated meta-model** to the enterprises”. (17 July 2007 Office Action, Page 4).

The Applicants respectfully submit that since *Fisher* in no way teaches “negotiation in reference to trade agreements”, ***which the Examiner acknowledges, Fisher*** simply cannot teach “communicating the **negotiated meta-model**.” Specifically, the Applicants respectfully submit that since *Fisher* does not teach negotiation in reference to trade agreements, *Fisher* therefore cannot teach “**negotiated meta-models**”. Put another way, as noted above, the Examiner has interpreted the term “**meta-model**” to mean a trade agreement which, of course, Applicants dispute. In addition, the Examiner acknowledges that *Fisher* does not teach “negotiation in reference to trade agreements”. Therefore, if *Fisher* does not teach negotiation in reference to trade agreements, which the Examiner has acknowledged and the Examiner has interpreted the term “**meta-model**” to mean

trade agreements then, according to the Examiner's own logic, *Fisher* simply cannot teach, suggest, or even hint at a “***negotiated meta-model***”.

The Proposed *Fisher-Byde* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Fisher* fails to disclose various limitations recited in independent Claim 1. Specifically, as noted above, the Examiner acknowledges that *Fisher* fails to disclose “negotiation in reference to trade agreements.” (17 July 2007 Office Action, Page 4). Notwithstanding this acknowledgement, the Examiner nevertheless asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fisher to include more details regarding negotiations.” (17 July 2007 Office Action, Page 4). Elaborating on the specific details that would supposedly have been obvious to include, the Examiner asserts that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fisher to include the specific details of structure of transaction, data elements, state model describing the cycle, accessing that a role type has data elements, or actions that a role type can execute. (17 July 2007 Office Action, Page 24).

The Applicants respectfully disagree and respectfully traverse the Examiner's assertions regarding the alleged motivation to combine references allegedly provided by *Fisher*.

In addition, the Applicants further respectfully submit that *Byde* fails to disclose, teach, or suggest negotiation in reference to trade agreements.” 17 July 2007 Office Action, Page 4), as asserted by the Examiner. Notwithstanding the fact that the Examiner acknowledges, and the Applicants agree, that *Fisher* fails to disclose “negotiation in reference to trade agreements,” the Examiner nevertheless asserts that “***[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fisher to include more details regarding negotiations***”. (17 July 2007 Office Action, Page 4).

In light of the Examiner's clear acknowledgement that *Fisher* fails to disclose "negotiation in reference to trade agreements," the Applicants respectfully submit that it would not, clearly would not have been obvious "to include more details regarding negotiations" in *Fisher* when, by the Examiner's own admission, *Fisher* does not teach "negotiations in reference to trade agreements," at all. Therefore, it is logically inconsistent to assert that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Fisher* to include more details regarding negotiations" when, once again, *Fisher* is completely silent as to "negotiation in reference to trade agreements. For at least these reasons, the Applicants respectfully submit that the basis underlying the Examiner's assertion cannot be logically supported.

The Applicants further respectfully submit that the ***Examiner has apparently taken official notice of what constitutes the level of ordinary skill in the art***, and has further ***improperly relied upon the officially-asserted level of skill in the art in order to provide motivation***. The Applicants respectfully traverse this taking of Official Notice. As set forth more fully below, it is improper for an Examiner to rely on the level of skill in the art as a basis to provide motivation.

The Level of Skill in the Art Cannot be Relied Upon to Provide a Suggestion to Combine References

As noted above, the Examiner has attempted to use the apparent officially-noticed finding of the level of skill in the art to improperly find motivation to combine references. It is well-settled that ***"the level of skill in the art cannot be relied upon to provide the suggestion to combine references."*** *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed.Cir. 1999). (Emphasis added). Put another way, "obviousness can ***only*** be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so." *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). It is clear that the "rationale underlying the motivation-suggestion-teaching requirement is as a guard against using hindsight in an obviousness analysis." MPEP §2143.01, citing *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir.

2006). Moreover, it is clear that an Examiner must only “rely on objective evidence and mak[e] specific factual findings with respect to the motivation to combine references.” MPEP §2143.01, citing *In re Lee*, 277 F.3d 1338, 1342-1344, 61 USPQ2d 1430, 1433-34 (Fed.Cir. 2002).

Once again, contrary to the assertions that the Examiner has made in the instant matter, the level of skill in the art **cannot** be relied upon to provide the requisite suggestion to modify. Therefore, the Applicants respectfully submit that the Examiner has improperly relied upon the level of skill in the art at the time of the Applicants invention to provide motivation. Accordingly, since the Examiner’s use of the level of skill in the art at the time of applicants’ invention is clearly impermissible, the finding of obviousness on this point must be withdrawn. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Fisher* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Fisher* and/or *Byde*.

Examiner has Improperly Taken Official Notice

In addition to the foregoing, the Examiner has asserted that “[t]hough Fisher may not state negotiations around the term trade agreement it is viewed that trade agreements require by nature negotiations”. The Applicants respectfully traverse the Examiner’s taking of Official Notice.

Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion.*** (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiner’s purported Official Notice.

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being*

well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘*capable of such instant and unquestionable demonstration as to defy the dispute*’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” (MPEP § 2144.03(A)).

“It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that *general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection*). Accordingly, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submits that ***the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner***, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicants further submit that the Applicants

have adequately traversed the Examiner's assertion of Official Notice and direct the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, should the Examiner continue to maintain the rejections of Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 based upon the Examiner's Official Notice, Applicants respectfully request that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further required by MPEP § 2144.03(C).

The Proposed *Fisher-Byde-McCormick* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that *Fisher*, *Byde*, or *McCormick*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 4, 5, 14, 15, 24, and 25. Thus, the Applicants respectfully traverse the Examiners obvious rejection of Claims 4, 5, 14, 15, 24, and 25 under 35 U.S.C. § 103(a) over the proposed combination of *Fisher*, *Byde*, or *McCormick*, either individually or in combination.

The Office Action Acknowledges that *Fisher* Fails to Disclose Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Fisher* fails to disclose various limitations recited in independent Claim 1. In particular the Examiner acknowledges that *Fisher* fails to teach *inter alia*, data elements. Therefore, the Applicants respectfully submit that the Applicants are confused as to what the Examiner asserts that *Fisher* does in fact teach. For example, if *Fisher* fails to teach data elements, as admitted to by the Examiner, then what type of ***meta-model elements*** does the Examiner assert that *Fisher* teaches. The Applicants respectfully request clarification from the Examiner.

The Applicants Claims are Patentable over the Proposed *Fisher-Byde-McCormick* Combination

The Applicants respectfully submit that, as discussed above, independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher*, *Byde*, or *McCormick*.

Furthermore, with respect to dependent Claims 2-10, 12-20, and 22-30: Claims 2-10 depend from independent Claim 1; Claims 12-20 depend from independent Claim 11; and Claims 22-30 depend from independent Claim 21. As mentioned above, each of independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher*, *Byde*, or *McCormick*. Thus, dependent Claims 4, 5, 14, 15, 24, and 25 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 1-31 are not rendered obvious by the proposed combination of *Fisher*, *Byde*, or *McCormick*. The Applicants further respectfully submit that Claims 1-31 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-31 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

12 October 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184